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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,721	12/01/2000	John Bertin	07334-315001	5307

7590 10/02/2002  
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EXAMINER

MCGARRY, SEAN

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 10/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**FILE COPY****Office Action Summary**

Application No.

09/728,721

Applicant(s)

BERTIN, JOHN

Examiner

Sean R McGarry

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.


**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: 

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, and 12, drawn to an isolated nucleic acid molecule, classifiable in class 536, subclass 23.1.
- II. Claims 8-10, drawn to an isolated polypeptide, classifiable in class 530, subclass 350.
- III. Claims 11 and 13-15, drawn to an antibody, classifiable in class 530, subclass 387.1.
- IV. Claims 16-18, drawn to a method of detecting a nucleic acid and a kit therefore, classifiable in class 435, subclass 6, and class 536, subclass 24.3.
- V. Claims 19, 20, and 21, drawn to a method for identifying compounds that bind to a protein, classifiable in class 435, subclass 7.1.
- VI. Claim 21, drawn to a method of inhibiting protein function, classifiable in class 514, subclass 2.

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the Groups above are further restricted to a single sequence recited in the claims. The Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, up to 10 of independent and distinct nucleotide sequences will be examined in a single application. (see MPEP 803.04 and 2434)

A search of more than one (1) of the sequences claimed presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed sequences. In view of the foregoing, one (1) sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicants are required to elect one (1) sequence.

The sequences are further defined as single inventions in that each sequence represents a different nucleic acid/protein that represents a composition that differs in structure (sequence) and biological properties, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions IV and VI, and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different method that comprised different method step, which use different compounds where the different method steps utilizing different compounds result in different means, for example.

Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different chemical compositions comprising different chemical constituents where the structure of the compositions and/or their

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different chemical components provides the compositions different chemical and biological activities, for example.

Inventions I-III and IV-VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the compounds of Groups I-III can be used in different methods than those of IV-VI. The nucleic acid of Group I could be used to make a protein, for example, the antibody of Group II could be used in an in situ localization assay, and the protein of Group II could be used to isolate antibodies, for example.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

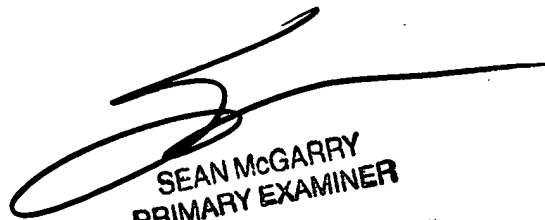
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean R McGarry whose telephone number is (703)305-7028. The examiner can normally be reached on M-Th (6:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SRM  
October 1, 2002



SEAN MCGARRY  
PRIMARY EXAMINER  
1635